

REMARKS

Claims 38-69 are pending in this application.

Claims 38-69 have been canceled without prejudice or disclaimer and claims 70-97 have been added by the present Amendment. New claims 70-97 do not introduce any new subject matter.

Claims 71-93 are original claims 2-24, which are being reinstated. Claim 70 is original claim 1 amended to include the following limitation: "wherein the common voltage applying member is disposed between a first peripheral area of the first substrate and a second peripheral area of the second substrate".

Support for the subject matter in new claims 94-97 can be found, for example, in Figs. 1 and 16-20 and their corresponding descriptions.

The following addresses the rejections of claims 1-24 (now claims 70-93) which appeared in the November 30, 2005 Office Action.

REJECTIONS UNDER 35 U.S.C. § 102

Reconsideration is respectfully requested of the rejection of claims 1-3, 5-9 and 10-12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,392,735 ("Tani"). Claims 1-3, 5-9 and 10-12 are now claims 70-72, 74-78 and 79-81.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131.

Applicants respectfully submit that Tani does not disclose or suggest the common voltage applying member disposed between a first peripheral area of the first substrate and a second peripheral area of the second substrate, as recited in claim 70. Therefore, Applicants respectfully submit that claim 70 is not anticipated by Tani. In addition, for at least the reason that claims 71-72, 74-78 and 79-81 depend from claim 70, claims 71-72, 74-78 and 79-81 are also not anticipated by the cited reference.

For example, Applicants' specification states that the common voltage applying member 300 is disposed between the first peripheral area PA1 of the first substrate 100 and the second peripheral area of the second substrate 200. See, e.g., page 7, lines 10-12; Figs. 1-2.

In contrast to the claimed embodiment, the columnar spacer CS cited by the Examiner and shown in Fig. 7 of Tani is not disposed between peripheral areas of first and second substrates. Instead, the columnar spacer CS shown in Tani is disposed between display areas. Accordingly, Tani does not disclose or suggest the claimed common voltage applying member disposed between a first peripheral area of a first substrate and a second peripheral area of a second substrate, as recited in claim 70.

Therefore, Applicants respectfully submit that independent claim 70 is not anticipated by Tani. Further, for at least the reason that claims 71-72, 74-78 and 79-81 depend from claim 70, which, for the reasons stated hereinabove, is submitted not to be anticipated by the cited reference, claims 71-72, 74-78 and 79-81 are also submitted not to be anticipated by the cited reference.

Further, Applicants respectfully submit that Tani fails to disclose or suggest a planarizing layer formed between the insulator and the conductor of the common

voltage-applying member, as recited in claim 81.

Indeed, as shown and described in Tani, the counter electrode 23 is formed on the blue portion of the color filter layer 22". There is no disclosure or suggestion to position a planarizing layer between the color filter 22" and the counter electrode 23.

Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-3, 5-9 and 10-12 (now claims 70-72, 74-78 and 79-81) under 35 U.S.C. § 102(b) and that claims 70-72, 74-78 and 79-81 are in condition for allowance.

REJECTION UNDER 35 U.S.C. § 103(a)

Reconsideration is respectfully requested of the rejection of claims 4, 10 and 13-24 under 35 U.S.C. § 103(a) as being unpatentable over Tani as applied to claims 1-3, 5-9 and 10-12. Claims 4, 10 and 13-24 are now claims 73, 79 and 82-93.

**Claims 73, 79 and 82-93 Are Patentable Over Tani
At Least By Virtue Of Their Dependency On Claim 1**

As stated above, Applicants respectfully submit that Tani fails to teach or suggest the common voltage applying member disposed between a first peripheral area of the first substrate and a second peripheral area of the second substrate, as recited in claim 70. Further, it would not have been obvious to modify Tani to result in same.

Indeed, there is no teaching or suggestion in Tani to form the common voltage applying member between a first peripheral area of the first substrate and a second peripheral area of the second substrate. Any modification to Tani would be based on hindsight reasoning based on information gleaned from Applicants' disclosure.

As such, Applicants respectfully submit that the embodiment of the invention as recited in claim 70 is patentable over Tani. For at least the reason that claims 73, 79 and 82-93 depend from claim 70, claims 73, 79 and 82-93 are also submitted to be

patentably distinct over the cited reference.

The Examiner Has Failed To Establish A Prima Facie Case
Of Obviousness At Least With Respect To Claims 88, 91 And 92

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. See In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); M.P.E.P. § 2142. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

With respect to claims 91 and 92 (formerly claims 22 and 23), the Examiner provides no explanation as to how and where Tani discloses (1) a black matrix formed over a common electrode, as recited in claim 91; and (2) a concavo-convex portion of the conductor that is in contact with a corresponding concavo-convex portion of the common electrode, as recited in claim 92. Indeed, the Examiner has not explained why Tani would have fairly suggested these elements to one of ordinary skill in the art, nor has the Examiner provided any convincing line of reasoning for the obviousness determination.

Similarly, with respect to claim 88 (formerly claim 19), the Examiner merely restates the claim language and states that Tani discloses the claim elements (see Examiner's rejection of claim 12). The Examiner generally points to Fig. 7 of Tani as disclosing the claim elements, but omits any discussion linking the Figure to the claim elements.

As stated above, a review of Fig. 7 of Tani reveals that Tani, at the very least, does not appear to disclose or suggest the planarizing layer formed between the insulator and the conductor of the common voltage-applying member, as recited in claim 88.

Applicants respectfully submit that the Examiner's reasoning in support of the obviousness rejections is based almost entirely on speculation and conjecture and relies on Applicants' disclosure and teachings to supply that which the cited reference lacks.

Accordingly, for at least the above reasons Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of at least claims 88, 92 and 93 (formerly claims 19, 22 and 23).

Therefore, Applicants respectfully submit that claims 88, 92 and 93 are patentable over Tani, when taken alone, or in combination with the Examiner's remarks.

Accordingly, in view of the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 4, 10 and 13-24 under 35 U.S.C. § 103(a) and that claims 73, 79 and 82-93 are in condition for allowance.

DEPENDENT CLAIMS

Applicants have not independently addressed the rejections of all the dependent claims because Applicants submit that for at least similar reasons as why the independent claims from which the dependent claims depend are believed allowable as discussed, *supra*, the dependent claims are also allowable. Applicants, however, reserve the right to address any individual rejections of the dependent claims should such be necessary or appropriate.

An early and favorable reconsideration is earnestly solicited. If the Examiner has any further questions or comments, the Examiner may telephone Applicants' Attorney to reach a prompt disposition of this application.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Michael F. Morano", is written over a horizontal line.

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